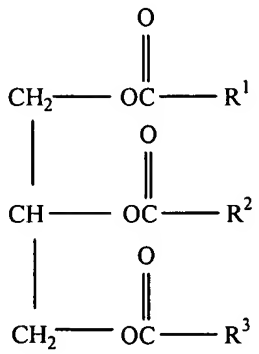
REMARKS

Favorable reconsideration and allowance of all pending claims in view of the following remarks is respectfully requested.

Claims 1-31 are pending in this application.

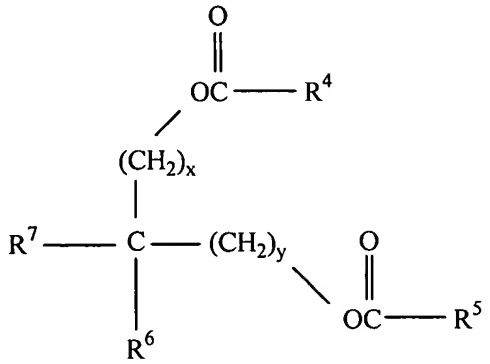
The Examiner has rejected Claims 1-11, 15, 18-22 and 26-31 under 35 U.S.C. §102(b) as being anticipated by Kodali et al. U.S. Patent No. 6,278,006 ("Kodali et al."). The rejection of Claims 1-11, 15, 18-22 and 26-31 as being anticipated by Kodali et al. is respectfully traversed.

In contrast to the presently claimed invention, Kodali et al. fail to disclose a lubricating oil composition within the scope of Claim 1, comprising, "(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester". Kodali et al. also fail to disclose a lubricating oil composition within the scope of Claim 15, comprising, "(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



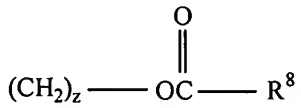
(I)

wherein R^1, R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



(II)

wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms".

In the Office Action, the Examiner maintains that "unreacted triacylglycerol polyol esters, such as IMC-130 oil, are deemed to read on applicant's claimed 'base oil of lubricating viscosity' (i.e., component (a)), wherein the transesterified reaction product of triacylglycerol polyol ester with a non-glycerol polyol ester are deemed to read on applicant's component (b). Applicant's claims are deemed to be anticipated over Example 4 wherein a model is constructed for the transesterification of IMC-130 oil and TMPTH as shown in FIG. 3. A review of FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15%), the concentration of the transesterified reaction product of IMC-130 oil and TMPTH is in a minor

amount compared to the concentration of the unreacted IMC-130 oil which would be in a major amount." [Original Emphasis]

This wholly unsupported assertion cannot possible serve as a basis for this rejection. It is not seen where Kodali et al. disclose a base oil of lubricating viscosity, much less a major amount of a base oil of lubricating viscosity, combined with a minor deposit-inhibiting effective amount of the recited reaction product to form a lubricating oil composition of Claims 1 and 15. Instead, Example 4 in Kodali et al. discloses the *reaction product* of IMC 130 oil with TMPTH. Example 4 was carried out to develop a statistical model based on a random distribution to determine how the long chain fatty acids of IMC 130 oil TAGs and the short chain fatty acids of the non-glycerol ester would be distributed when short chain fatty acid esters were transesterified with IMC-130 oil at different concentrations. As stated in column 11, lines 1-6 of Kodali et al., transesterifying about 20-25% TMPTH by weight with IMC-130 oil yields a large number of TAGs with one short chain, and modifies over 70% of the original TAGs found in IMC-130. Figure 3 shows the results of the model as a graph of the predicted fatty acid distribution of the TAGs of TMPTH and IMC-130 transesterified products at different concentrations. Contrary to the Examiner's assertion, nowhere in Example 4 or Figure 3 is there any disclosure of a lubricating oil composition containing a major amount of a base oil of lubricating viscosity and a minor amount of the recited reaction product. As stated above, Example 4 and Figure 3 merely disclose the reaction product of IMC 130 oil and TMPTH. Any unreacted component such as IMC-130 would merely be a part of the reaction product. Thus, applicants respectfully disagree with the Examiner.

For the foregoing reasons, Kodali et al. do not disclose all of the elements and limitations of the claimed invention. Accordingly, Claims 1-11, 15, 18-22 and 26-31 are believed to be patentably distinct over Kodali et al. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 12 and 23 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Kodali et al.

The foregoing deficiencies of Kodali et al. discussed above with respect to the rejections of Claims 1 and 15, from which Claims 12 and 23 ultimately depend, apply with equal force to this rejection. As Kodali et al. nowhere disclose a lubricating oil composition as presently recited in amended Claims 1 and 15, Kodali et al. certainly cannot disclose the limitations of dependent Claims 12 and 23 for at least the same reasons. Accordingly, rejected Claims 12 and 23 are believed to possess novel subject matter relative to Kodali et al.

There is likewise no disclosure or suggestion in Kodali et al. of a lubricating oil composition within the scope of Claims 1 and 15, comprising, (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the recited reaction product". In addition, there is likewise no disclosure or suggestion in Kodali et al. of a lubricating oil composition within the scope of Claims 12 and 23, comprising, *inter alia*, "about 0.1 to about 8 wt. %, based on the total weight of the composition the minor deposit-inhibiting effective amount of the reaction product.

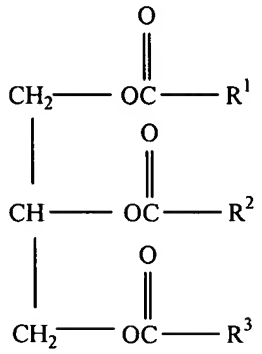
Instead, Kodali et al. simply disclose base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester. At no point is there any suggestion, motivation or even a hint in Kodali et al. of employing a minor deposit-inhibiting effective amount of the specifically recited reaction product in a lubricating oil

composition much less a lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product. Thus, nothing in Kodali et al. would lead one skilled in the art to modify the base oils prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester as disclosed therein and arrive at the specifically recited lubricating oil compositions of amended Claims 1 and 15, from which Claims 12 and 23 depend. Further, nothing in Kodali et al. would lead one skilled in the art to modify the base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester as disclosed therein and arrive at the lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product wherein the minor deposit-inhibiting effective amount of the reaction product is about 0.1 to about 8 wt. %, based on the total weight of the composition as recited in Claims 12 and 23. As such, Claims 12 and 23 are also believed to be non-obvious, and therefore patentable, over Kodali et al.

The Examiner has rejected Claims 1-31 under 35 U.S.C. §103(a) as being unpatentable over Lal U.S. Patent No. 5,338,471 ("Lal") in view of Kodali et al.

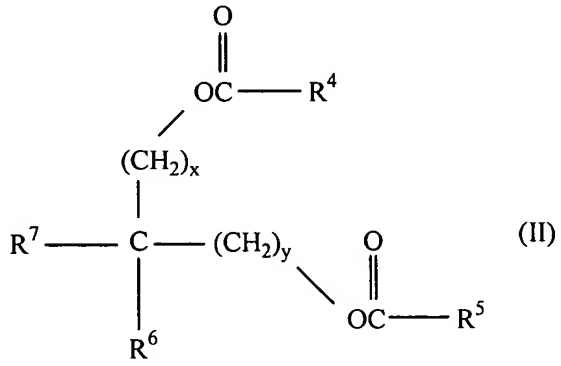
As acknowledged by the Examiner, Lal fails to disclose a lubricating oil composition within the scope of amended Claim 1, comprising, *inter alia*, "a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester". As further acknowledged by the Examiner, there is no disclosure or suggestion in Lal of a lubricating oil composition within the scope of Claim 15,

comprising, *inter alia*, "a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



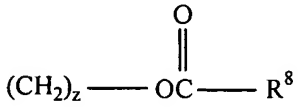
(I)

wherein R^1, R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



(II)

wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms".

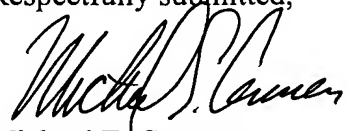
Rather, Lal simply discloses a composition comprising (A) at least one vegetable or synthetic triglyceride oil; (B) esters from the transesterification of at least one animal or vegetable oil triglyceride with an alcohol or phenol; (C) a pour point depressant; (D) at least one performance additive and optionally (E) at least one oil selected from the group consisting of (1) synthetic ester base oil, (2) a mineral oil; (3) a polyalphaolefin; and (4) a vegetable oil. It is not seen where Lal provides any suggestion, motivation or even a hint of a lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product.

Kodali et al. do not cure the deficiencies of Lal. It is well established that to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Kodali et al. simply disclose base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester, which may contain other additives. At no point is there any suggestion, motivation or even a hint in Kodali et al. that the oil disclosed therein can be combined with a major amount of a base oil of lubricating viscosity in a minor deposit-inhibiting effective amount to form a lubricating oil composition such that the composition provides deposit protection in addition to high antiwear and oxidation-corrosion protection in an engine. Thus, nothing in Kodali et al. would lead one skilled in the art to modify the compositions of Lal by looking to the disclosure of Kodali et al. and arrive at the presently claimed lubricating oil composition with any expectation of success. As such, Claims 1-31 are believed to possess patentable subject matter

over Lal in view of Kodali et al. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

For the foregoing reasons, Claims 1-31 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg